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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,916	10/24/2003	Michael Roberts	00216-368005	9057
26161	7590	08/13/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			SPISICH, MARK	
			ART UNIT	PAPER NUMBER
			1744	
DATE MAILED: 08/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/692,916	ROBERTS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark Spisich	1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 25,33-37,45-49 and 55-60 is/are pending in the application.
- 4a) Of the above claim(s) 25,33-37 and 45-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 25,33-37 and 45-49 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 25 March 2004.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on 24 June 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USP 6,151,745 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Information Disclosure Statement***

Receipt is acknowledged of papers filed 6 July 2004 as a disclosure statement. These papers do not make any specific documents of record but merely pertain to opposition correspondence in a related EP patent. These papers have been noted.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 55-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant, in the amendment of 24 June 2004, added the phrase "**to a radiused terminal end** to contact one or more teeth" (emphasis added) (claim 55, lines 6-7). A review of the present specification found no instance where the elastomeric element/bristle is described as radiused at the terminal end thereof. This is significant in that applicant is asserting that this feature is the distinguishing claim feature with regard to the previously applied patent to Birch (USP 3,103,027).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over McVeigh (USP 1,796,893) in view of Michaels (USP 5,040,260). The patent to McVeigh discloses an oral brush comprising a handle (1), head portion (2) extending from an end of the handle and a brush portion comprising "one or more" elastomeric element(s) (4) (page 1, lines 40-42) having a "radiused" end (5) which is provided for cleaning and polishing the surfaces of the teeth and a plurality of non-elastomeric bristles (3) and further wherein the elastomeric element extends in substantially the same direction as the bristles (3). The patent to McVeigh discloses the invention substantially as claimed with the exception of the particular material of the elastomeric

element. The patent to Michaels discloses elastomeric elements (6) for cleaning and polishing the teeth (column 1, lines 7-10) and which comprise "SANTOPRENE" (column 5, line 2), which is the preferred "polyolefin elastomer" of the present application (see page 7, line 3) and which is one of the recited materials recited in claim 55 (lines 8-11). It would have been obvious to one of ordinary skill to have modified the device of McVeigh for the same reasons set forth in the patent to Michales (column 3, lines 19-26). Claim 57, which merely states that the elastomer is "sufficiently soft", does not materially define over the prior art.

7. Claims 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolinsky (USP 4,288,883) in view of Michaels (USP 5,040,260). The patent to Dolinsky discloses an oral brush (10) comprising a handle (11), head portion (14,18,20) extending from an end of the handle and a brush portion comprising at least one elastomeric element (22a) having rounded ends (i.e. "radiused") as well as a plurality of non-elastomeric bristles (16) with the elastomeric element extending in substantially the same direction as at least some of the bristles. The patent to Dolinsky discloses the invention substantially as claimed with the exception of the particular elastomer. It would have been obvious to one of ordinary skill to have modified the element(s) (22a) as taught by Michaels for the same reason set forth above.

8. Claims 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weideman (USP 4,277,862) in view of Michaels (USP 5,040,260). The patent to Weideman discloses an oral brush (10) comprising a handle (12), head portion (16) extending from the handle and a brush portion including at least one elastomeric

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element (18) (column 2, lines 38-42) having a "radiused" terminal end and a plurality of non-elastomeric bristles.(14). The patent to Weideman discloses the invention substantially as claimed with the exception of the specific elastomer. It would have been obvious to one of ordinary skill to have modified the device of Weideman as taught by Michaels for the same reason set forth above.

9. Claims 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over McVeigh (USP 1,796,893), Dolinsky (USP 4,288,883) or Weideman (USP 4,277,862) in view of Michaels (USP 5,040,260) as applied to claim 55 above, and further in view of Muhler et al (USP 3,613,143). The patents to McVeigh, Dolinsky and Weideman as modified by Michaels each disclose the invention substantially as claimed with the exception of the particulars of the non-elastomeric bristles (3 in '893, 16 in '883 and 14 in '862). The use of polyamide for toothbrush bristles is well known in the art and the patent to Muhler discloses (1) toothbrush bristles of nylon (a polyamide); (2) the nylon material including an abrasive additive (column 7, lines 36-52); and (3) the bristles having a diameter of 8 mil (within the recited range of claim 60). It would have been obvious to one of ordinary skill to have modified the non-elastomeric bristles of any one of McVeigh, Dolinsky and Weideman as taught by Muhler to enhance tooth cleaning and polishing.

***Allowable Subject Matter***

10. Claim 56 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

11. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (6-3:30), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (571) 272-1281. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Spisich  
Primary Examiner  
Art Unit 1744

MS